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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/521,046

12/27/2005

Peter Zimmerman

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09/16/2008

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EXAMINER

LIU, XUE H

ART UNIT

PAPER NUMBER

1791

NOTIFICATION DATE

DELIVERY MODE

09/16/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com

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<b>Office Action Summary</b>	<b>Application No.</b> 10/521,046	<b>Applicant(s)</b> ZIMMERMAN, PETER	
	<b>Examiner</b> XUE LIU	<b>Art Unit</b> 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 1 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 January 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/7/05</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1, drawn to a method for molding a beaker having a label on the outer circumference by transferring a preformed label into the mold cavity.

Group II, claim(s) 2-13, drawn to an apparatus for molding a beaker having a label on the outer circumference comprising a preformer configured to preform the label before it's transferred into the mold cavity.

2. The inventions listed as Groups I-II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the common technical feature in all groups is preforming the label before it is transferred into the mold cavity. This element cannot be a special technical feature under PCT Rule 13.2 because the element is shown in the prior art. EP 0395585 A2 teaches a method and apparatus for preforming a label before it is transferred into the mold cavity.

3. During a telephone conversation with Thomas Arno on 8/28/08 a provisional election was made without traverse to prosecute the invention of group II, claim3. Affirmation of this election must be made by applicant in replying to this Office action. Claim 1 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Drawings***

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the injection mold having two mold halves must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 2-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 2, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d). Claims 3-13 are rejected for depending on claim 2.

Claim 3 recites the limitation "the injection molding tool" in line 3 of the claim. There is insufficient antecedent basis for this limitation in the claim. Claim 4 is rejected for being dependent on claim 3.

Claim 5 recites the limitation "the preform cavity" in the second line of the claim. There is insufficient antecedent basis for this limitation in the claim. Claim 11 is rejected for depending on claim 5. For examining purposes, claims 5 and 11 are taken to depend on claim 3.

Claim 6 recites the limitation "the preform cavity" in the second line of the claim. There is insufficient antecedent basis for this limitation in the claim. For examining purposes, claim 6 is taken to depend on claim 3.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 2 is rejected under 35 U.S.C. 102(b) as being anticipated by Taki et al. (EP 0395585).

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Regarding claim 2, Taki et al. teach a device for fabricating an injection molded article 23 (fig. 7), on whose outer circumference a label 18 (figs. 1-9) is arranged, comprising: an injection mold having two mold halves (4, 4a in fig. 9b) which, in the closed stated, form a mold cavity corresponding to the shape of the article to be fabricated, and a transfer tool configured such that the label 18 is transferable into the mold cavity of a mold half 4 (col. 11, lines 10-15), characterized in that a preformer 7 (shown in figs. 1, 2(a), 4-5, 8(a), 9(a)) configured to preform the label 18 substantially into the shape in which the label 18 is to be inserted in the mold cavity of one mold half 4, wherein the transfer tool is configured to take up the preformed label 18 out of the preformer 7 and transfer it to the injection mold 4 (col. 11, lines 10-15).

***Allowable Subject Matter***

9. Claims 3-13 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter: Regarding claim 3, among the closest prior art, Taki et al. teach a preformer die 7 including an outer periphery 7a contoured to the size and shape conforming to at least the inner periphery 4a of the molding die 4 (col. 3, lines 10-18 and fig. 2). Taki et al. fail to teach a forming block having a preform cavity corresponding to the mold cavity of the injection molding tool. Taking the claim as a whole, it would not have been obvious to one of ordinary skill in the art to replace the preformer die in the invention of Taki et al. with a forming block having a preform cavity corresponding to the mold cavity of the injection molding tool since it would destroy the reference (for example, a transfer tool would be required to physically take up the label and

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transfer it to the injection mold, instead of turning the preformer die upside down and allow the label to fall into the injection mold as described in the other embodiment).

Regarding claims 4-13, the claims are dependent on claim 3 or teach a preform cavity and therefore contain the same allowable subject matter as claim 3.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to XUE LIU whose telephone number is (571)270-5522. The examiner can normally be reached on Monday to Thursday 7:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Phillip Tucker can be reached on (571)272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/X. L./

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/Philip C Tucker/

Supervisory Patent Examiner, Art Unit 1791